

REMARKS

The Applicants have amended the Specification to further enhance the understanding of its contents by the public, as well as to respond to the objections of the Examiner. No new matter has been entered.

The Examiner has withdrawn Claim 43 from consideration asserting that it is drawn to a non-elected invention. The Applicants have amended Claims 39, 40, 42, and 44-46 to more particularly point out and distinctly claim the subject matter that the Applicants regard as their invention, and in order to expedite the allowance of the application for business considerations. Support for the current amendments to the claims can be found throughout the instant Specification. No new matter has been entered. Claims 39-42 and 44-49 remain for consideration.

Reconsideration of the Application in view of the above amendments and the remarks below is respectfully solicited.

INFORMATION DISCLOSURE STATEMENT

The Examiner has indicated that a single reference (EP0 477 056) submitted by the Applicants is in a foreign language and therefore, he could not considered it.

The Applicants submit herewith a Supplemental Information Disclosure Statement, a Form-PTO 1449, and copies of the art cited. The Supplemental Information Disclosure Statement includes a Canadian patent application (2,050,850) that corresponds to EP0 477 056. This Canadian patent application is in English.

Consideration of the Supplemental Information Disclosure Statement is respectfully requested.

THE PRESENT APPLICATION DOES NOT INVOLVE DOUBLE PATENTING

The Examiner has rejected Claims 39-41 and 44-46 under the judicially created doctrine of obviousness double patenting in view of U.S. Patent Nos. 6,328,975, 6,497,882, 6,328,975, and 6,033,904. The Examiner has also provisionally rejected Claims 39-41 and 44-49 under the judicially created doctrine of obviousness double patenting in view of co-pending U.S. 09/994,064.

The Applicants respectfully traverse the Examiner's rejections. The Applicants have amended the claims to more particularly point out and distinctly claim the subject matter that the Applicants regard as their invention. The Examiner's rejections in view of the patents and patent application cited should now be moot.

In view of the above and foregoing withdrawal of the rejections and provisional rejection under the judicially created doctrine of obviousness double patenting is respectfully solicited.

THE PRESENT INVENTION COMPLIES WITH THE WRITTEN DESCRIPTION REQUIREMENT AND IS FULLY ENABLED

The Examiner has rejected Claims 39-42 and 44-49 under 35 U.S.C. § 112, first paragraph asserting that the claims fail to comply with the written description requirement.

The Examiner has also rejected Claim 41 under 35 U.S.C. § 112, first paragraph asserting that it is non-enabling because the Examiner asserts that the cDNA of Claim 41 does not encode a protein, but rather is the complement to the coding sequence.

The Applicants respectfully traverse the Examiner's rejections. The claimed invention fully complies with the written description requirement and is fully enabled.

The Applicants have amended the claims to more particularly point out

and distinctly claim the subject matter that the Applicants regard as their invention. These amendments should make the Examiner's rejections regarding the written description requirement moot.

In addition, the Applicants respectfully point out that cDNA may be either single stranded or double stranded. Therefore, a "cDNA that encodes a polypeptide" includes a double stranded nucleic acid and thereby, both the Watson and/or Cricke strands. Of course, as the Examiner implies, only one strand of a double-stranded cDNA encodes the polypeptide, with the other being the complementary strand.

In view of the above and foregoing withdrawal of the rejection under 35 U.S.C. § 112, first paragraph is respectfully solicited.

THE PRESENT INVENTION IS NOVEL

The Examiner has rejected Claims 39-41 under 35 U.S.C. §102 (b) as being anticipated by Sheppard *et al.* (WO 92/03554). The Examiner has also rejected Claims 39 and 40 under 35 U.S.C. § 102 (e) as being anticipated by Keeler *et al.* (US Patent No. 5,279,965).

The Examiner has further rejected Claims 39-41, 44-46, and 48 under 35 U.S.C. § 102 (e) as being anticipated by Cochran *et al.* (U.S. Patent No. 5,869,312). The Examiner indicates that a Declaration under 37 CFR 1.132 by one of the co-Inventors of the present patent application may overcome this particular rejection.

The Applicants respectfully traverse the Examiner's rejection of the Claims under 35 U.S.C. § 102. The claimed invention is not anticipated by the cited art. In order to anticipate a claim a cited reference must teach every element of the claim. Indeed, Section 2131 of the MPEP quotes the Federal Circuit as stating:

"[t]he identical invention must be shown in as complete detail as is contained in the ... claim" *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.Cir. 1989).

In the present case neither Sheppard *et al.*, nor Keeler *et al.*, teach the present invention as claimed. Moreover, the Applicants submit herewith a Declaration under 37 CFR 1.132, signed by Mark Cochran, one of the co-inventors of the present application. Dr. Cochran is also a co-inventor of U.S. Patent No. 5,869,312.

In the Declaration, Dr. Cochran states that the disclosure relating to ILVT gl in U.S. Patent No. 5,869,312 was based on a prior invention made by him in conjunction with Martha A. Wild. This prior invention included the subject matter of the pending claims of the present patent application. Therefore, disclosure regarding ILVT gl and its use in U.S. Patent No. 5,869,312 post-dates the present invention. Therefore, U.S. Patent No. 5,869,312 does not anticipate the present invention.

In view of the above and foregoing withdrawal of the rejections under 35 U.S.C. § 102 (b) and (e) is respectfully solicited.

No additional fees are believed to arise due to this filing, however, if any fees are required, the Commissioner is hereby authorized to charge any required fees to Deposit Account No. 19-0365.

The Applicants believe that the next step in the prosecution of this Application should be in the form of a Notice of Allowance and such action is respectfully solicited.

If the undersigned can be of any assistance to the Examiner in addressing issues to advance the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted,

A handwritten signature in black ink that reads "Michael D. Davis". The signature is written in a cursive style with a large, stylized "M" and "D".

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